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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,472	02/05/2004	Kenichi Sakamoto	NIT-408	2953
7590 Mattingly, Stanger & Malur, P.C. Suite 370 1800 Diagonal Road Alexandria, VA 22314			EXAMINER BARQADLE, YASIN M	
			ART UNIT 2456	PAPER NUMBER
			MAIL DATE 10/06/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/771,472

**Applicant(s)**

SAKAMOTO ET AL.

**Examiner**

YASIN M. BARQADLE

**Art Unit**

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-4, 8-9, 13-14 and 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3, 4, 8, 9, 13, 14 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 29, 2008 has been entered.

**Response to Amendment**

2. The amendment filed on August 29, 2008 has been fully considered but are not persuasive in view of the new grounds of rejection.

- Claims 3-4, 8-9, 13-14 and 18 are presented for examination.

**Note:** The prosecution for this case has been transferred to another Examiner. All corresponding communications should be directed to Examiner's contact information, provided below.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-4, 8-9, 13-14 and 18 **are rejected under 35 U.S.C. 103(a) as being unpatentable over Mulahusic (“SIP Issues in Dual-stack Environments”, Mulahusic et al., 2/27/2003) in view of Watanuki et al US Patent Number (6888845), hereinafter “Watanuki”.**

As to claim 3, Mulahusic teaches a session control system (SIP server) comprising:

a control unit for performing a process of establishing a session between communication terminals (hosts) connected to an IP network [see Scenario I shown on pages 3-4 and in Figure 1];

a receiving unit for receiving, from a first communication terminal (e.g., Alice's host), a session control request packet (Invite) to a second communication terminal (e.g., Bob's host) [see Scenario I shown on pages 3-4 and in Figure 1]; and

a transmitting unit for transmitting a notification (e.g., “Error Try(IPv4)”) to said first communication terminal (e.g., Alice's host) if an IP protocol version (IPv6) of said session control request packet (Invite) is different from an IP protocol version (IPv4) usable by said second communication terminal (e.g., Bob's host) [see Scenario I shown on pages 3-4 and in Figure 1],

wherein said receiving unit receives a packet having each of registration information for an IPv4 terminal and registration information for an IPv6 terminal [see the first paragraph of Scenario I on page 3 ("The host initiating the session is registered with its SIP server with both IPv4 and IPv6 addresses.")].

As to claim 3, Mulahusic discloses invention as explained above. However, Mulahusic does not expressly teach wherein the registration information for the IPv4 terminal being separate from the registration information for the IPv6 terminal.

Nonetheless, the registration information for an IPv4 terminal being separate from said registration information for an IPv6 terminal is well known in the art as disclosed by Watanuki (col. 3, lines 26-62 and col. 9, lines 26-51).

It would have been obvious for the ordinary artisan to have the registration information for the IPv4 terminal separate from the registration information for the IPv6 terminal. In this way devices with either IP version could be allowed to access networks with a dual stack capability.

As to claim 8, Mulahusic teaches a communication terminal (e.g., Alice's host) connected to a session control system (SIP server) via an IP network and capable of communication using the IPv4 protocol and communication using the IPv6 protocol, comprising:

a transmitting unit for transmitting to said session control system (SIP server), by using the IPv4 or IPv6 protocol (IPv6), a session control request (Invite) for requesting a session control to a communication terminal (e.g., Bob's host) to be a communication partner [see Scenario I shown on pages 3-4 and in Figure 1]; and

a receiving unit for receiving a notification ("Error Try(IPv4)") indicating that the communication protocol (IPv6) used for said session control request (Invite) is different from a communication protocol (IPv4) communicable with the communication terminal (e.g., Bob's host) to be said communication partner [see Scenario I shown on pages 3-4 and in Figure 1], wherein

upon receiving the notification ("Error Try(IPv4)"), a session control request (Invite) for requesting a session control to the partner communication terminal (e.g., Bob's host) is transmitted again by using a communication protocol (IPv4) communicable with the partner communication terminal (e.g., Bob's host) [see Scenario I shown on pages 3-4 and in Figure 1], and

wherein said transmitting unit transmits to said session control system a registration packet in which both of registration information for an IPv4 terminal and registration information for an IPv6 terminal is described [see the first paragraph of Scenario I on page 3 ("The host initiating the session is registered with its SIP server with both IPv4 and IPv6 addresses.")].

As to the limitation of wherein the registration information for the IPv4 terminal being separate from the registration information for the IPv6 terminal see rejection of claim 1 above.

As to claim 13, Mulahusic teaches a network system comprising an IP network, first and second communication terminals (e.g., Alice's and Bob's hosts) each connected to the IP network, and a session control system (SIP server) connected to the IP network, wherein

said first communication terminal (e.g., Alice's host) has a transmitting unit capable of transmitting a session control request (Invite) to said second communication terminal (e.g., Bob's host) by using each of an IPv4 packet and an IPv6 packet [see Scenario I shown on pages 3-4 and in Figure 1], and

said session control system (SIP server) is comprised of:

a session control unit for establishing a session between said first and second communication terminals (e.g., Alice's and Bob's hosts) [see Scenario I shown on pages 3-4 and in Figure 1];

a receiving unit for receiving the session control request (Invite) transmitted from said first communication terminal (e.g., Alice's host) [see Scenario I shown on pages 3-4 and in Figure 1]; and

a transmitting unit for transmitting to said first communication terminal (e.g., Alice's host), if an IP protocol version (IPv6) of said session control request (Invite) is different from an IP protocol version (IPv4) usable by the second

communication terminal (e.g., Bob's host), a notification ("Error Try (IPv4)") indicating that the IP protocols (IPv4 and IPv6) are different [see Scenario I shown on pages 3-4 and in Figure 1],

wherein the transmitting unit of said first communication terminal (e.g., Alice's host) transmits to said session control system a registration packet in which each of registration information for an IPv4 terminal and registration information for an IPv6 terminal is described [see the first paragraph of Scenario I on page 3 ("The host initiating the session is registered with its SIP server with both IPv4 and IPv6 addresses.")] , and

wherein the receiving unit of said session control system accepts the packet including said registration information and transmitted from said first communication terminal (e.g., Alice's host) [see the first paragraph of Scenario I on page 3 ("The host initiating the session is registered with its SIP server with both IPv4 and IPv6 addresses.")] .

As to the limitation of wherein the registration information for the IPv4 terminal being separate from the registration information for the IPv6 terminal see rejection of claim 1 above.

Regarding claim 18, this claim includes similar limitations of claims 1, 8 and 13. Therefore, it is rejected with same rationale.



As to claims 4, 9, and 14, Watanuki discloses where the packets having said registration information is an IPv4 packet or an IPv6 packet (col. 3, lines 26-62).

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yasin Barqadle whose telephone number is 571-272-3947. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Yasin M Barqadle/

P.S. Examiner, Art Unit 2153